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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,498	09/16/2003	James Scott Anderson	453.1	2443

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EXAMINER

SILBERMANN, JOANNE

ART UNIT PAPER NUMBER

3611

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/663,498	Applicant(s) ANDERSON, JAMES SCOTT	
	Examiner Joanne Silberman	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,10-17 and 20-51 is/are pending in the application.
- 4a) Of the above claim(s) 29-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,10-17,20-28, 34-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 29-33 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 10-13, 16 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downing, US #6,604,789.
4. Downing teach writing surface 35 and a semi-rigid core 16 supporting the writing surface (Figure 3). The core includes slot 20 sized to releasably receive an edge upon which it is mounted. The orientation of the slot is generally parallel to the writing surface. The core (and writing surface) may correspond with "any cross-sectional shape" or armrest. Various types of indicia may be applied to the surface. If such indicia is not removed, it is considered permanent.
5. Regarding the location of the writing surface, the edge and the open container are not part of the claimed invention. Such language is considered to be intended use only.

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6. Regarding claim 10, one side of the core (facing the left side of the sear, for example) provides a front writing surface, and the other side (facing the right side) provides a rear writing surface.

7. Regarding claim 11, Downing does not teach a plurality of slots, however this is considered to be a duplication of known parts. It has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

8. Downing does not teach a specific material to be used for the writing surface, however vinyl is old and well known. It would have been obvious to a person having ordinary skill in the art to utilize vinyl as a suitable material if it is desired to place water-soluble indicia on the display.

9. Downing does not teach the specific method steps of the instant claims, however such methods would have been obvious to one of ordinary skill in the art given the structure of Downing.

10. Claims 2, 15, 17 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downing in view of Schmeida, US #5,727,818.

11. Downing does not teach a whiteboard, however this is well known in the art. Schmeida teaches a labeling system including a writing surface for dry erase markers and includes a transparent covering (see Abstract). It would have been obvious to one of ordinary skill to utilize a whiteboard surface so that the display may be easily erased and changed, and a transparent cover to protect the display.

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12. Downing and Schmeida do not teach methods, however the method steps would have been obvious for the same reasons as above.

13. Claims 4-7 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downing in view of Hutchens, US #5,581,921.

14. Downing does not teach a projection, however displays including such projections are well known, as shown by Hutchens. Hutchens teaches a display including projection 6 having several straight surfaces and extending perpendicularly to surface 22 (Figure 3) having permanent indicia thereon. The projection is considered to be sized and shaped to prevent inadvertent erasure of the indicia. It would have been obvious to one of ordinary skill in the art to utilize such a projection on the device shown by Downing so that the indicia may be more easily seen.

15. Claims 14 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downing in view of Roche et al. US #5,384,999.

16. Downing does not teach a metallic core, however such a surface is well known in the art. Roche et al. teach a display including magnetic layer 14. It would have been obvious to one of ordinary skill in the art to utilize such a magnetic layer in the display of Downing so that magnetic display elements may be used, as described in Roche et al. The methods would have been obvious as discussed above.

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17. Claims 34-38, 40-47 and 49-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weller, US #3,526,050 in view of Schmeida.

18. Weller teaches an assembly including generally planar surfaces 14, 15 (Figures 1 and 2) for receiving indicia, semi-rigid core 10 supporting the writing surface and having a thickness and top and bottom sides, and slot 16 (Figure 2) extending upward from the bottom side to a depth terminating near the lower boundary of the writing surface such that a majority of the writing surface extends above the slot (Figure 1).

19. Weller teaches surfaces 14 and 15 for receiving indicia but does not specifically describe writing surfaces. This however is well known in the art, as shown by Schmeida. Schmeida teaches a dry-erase (whiteboard) writing surface for applying indicia to a substrate and includes releasably adhered transparent cover 16 (Figure 1). It would have been obvious to a person having ordinary skill in the art to utilize the surface shown in Schmeida to provide indicia on the core of Weller so that indicia/advertisement may be provided on the core. If the indicia are not removed, it is considered to be permanent.

20. The front and rear surfaces face opposite directions.

21. Weller and Schmeida do not teach using vinyl for the writing surface, however vinyl is old and well known. It would have been obvious to a person having ordinary skill in the art to utilize vinyl as a suitable material if it is desired to place water-soluble indicia on the display.

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22. Regarding the location of the writing surface in relation to the edge of the container, the edge and the container are not part of the claimed invention. Such language is considered to be intended use only.

23. Regarding claim 42, Weller and Schmeida do not teach a plurality of slots, however this is considered to be a duplication of known parts. It has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

24. Claims 39 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weller and Schmeida as applied to claims 34 and 43 above, and further in view of Roche et al. US #5,384,999.

25. Weller and Schmeida do not teach a metallic core, however such a surface is well known in the art. Roche et al. teach a display including magnetic layer 14. It would have been obvious to one of ordinary skill in the art to utilize such a magnetic layer in the display of Downing (as modified) so that magnetic display elements may be used, as described in Roche et al.

26. The methods would have been obvious as discussed above.

Response to Arguments

27. Applicant's arguments filed 27 September 2006 have been fully considered but they are not persuasive.

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28. Regarding the rejections under Downing, Applicant argues that Downing does not use the words "writing surface" anywhere in the Specification. The examiner realizes that these exact words are not used, however Downing teaches a surface having indicia thereon. Giving the claims their broadest, reasonable interpretation, any surface that can be written on is a writing surface. Downing clearly shows such a surface.

29. Regarding the recitation of the display with respect to the edge of the container, Applicant states that the position of the writing surface relative to the slot does not change with respect to the container, however the claim language (particularly claim 1) recites the majority of the writing surface extending beyond the edge of the container. It appears that the container does in fact define the writing surface, which the examiner considers to be intended use.

30. As for the new claims, the slot is defined irrespective of the container and/or edge and new art has been applied to these claims.

Conclusion

31. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

32. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Silbermann whose telephone number is 571-272-6653. The examiner can normally be reached on M-F 5:30 - 2:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Joanne Silberman
Primary Examiner
Art Unit 3611

js
16 November 2006